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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,889	04/10/2001	Toshio Yagihashi	Q63958	7824

7590 07/28/2004

SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER
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SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 09/828,889	<b>Applicant(s)</b> YAGIHASHI ET AL.	
	<b>Examiner</b> Cristina O Sherr	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to the after-final amendment filed 09 July 2004. Claims 1-27 are pending in this case.
2. The finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 July 2004 has been entered.

### ***Response to Arguments***

3. Applicant's argument, see after final amendment, filed 09 July 2004, with respect to the rejections of claims 1-27 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Shear (US 5,410,598A).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear (US 5,410,598A).

6. Regarding claims 1 and 18-21 –

Shear discloses a network-based service system, comprising database server for storing a database containing information on vendors, and other know-how that are registered by a vendor in advance via a network; terminal to search said database, and account terminal for paying a royalty for utilizing the database from the bank account of

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the user to the bank account of the vendor upon utilization of database (e.g. Col. 3 ln 60 – col 4 ln 60).

7. Regarding claim 2 –

Shear discloses the network-based design service system as set forth in claim 1, wherein said terminal searches said database on a WWW site, and conducts a project (e.g. Col 4 ln 20-20).

8. Regarding claim 3 –

Shear discloses the network-based service system as set forth in claim 1, wherein said account terminal has a function for paying an employment fee from a bank account of a parts vendor to the bank account of the user upon employment of the database (e.g. Col 6 ln 25-40).

9. Regarding claim 4 –

Shear discloses the network-based service system as set forth in claim 1, comprising: means for notifying other terminals if a problem is found in a sample during the process (e.g. col 7 ln 20-35).

10. Regarding claim 5 –

Shear discloses the network-based service system as set forth in claim 1, comprising: means for the user to conduct design, and determine parts to employ through price simulation for meeting a target price (e.g. col 8 ln 25-40).

11. Regarding claim 6 –

Shear discloses the network-based service system as set forth in claim 1, comprising means for notifying other terminals if a problem is found during the process for the

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device; and means design for the device, and determine parts to employ through price simulation for meeting a target price (e.g. col 8 ln 25-40).

12. Shear does not expressly a database for use in field of designing circuits. However, these differences are found only in the non-functional data stored in the database. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F2d 1381, 1385, 217 USPQ 401,404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579,32 USPQ2d 1031 (Fed.Cir.1994).

13. Claims 7-12 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear (US 5,410,598A).

14. Regarding claims 7 and 22-24 –

Shear discloses a network-based design method, comprising the steps of a vendor registering on a database server various kinds of information, in advance via a network; a user searching said database, determining conditions autonomously, and conducting the design of a device; and paying a royalty for utilizing the database from the bank account of the user to the bank account of the vendor upon utilization of said design database (e.g. Col. 3 ln 60 – col 4 ln 60).

15. Regarding claim 8 –

Shear discloses the network-based method as set forth in claim 7, wherein said design step searches said database on a WWW site and conducts the design of a device (e.g. Col 4 ln 20-40).

16. Regarding claim 9 –

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Shear discloses the method of claim 7, further comprising the step of paying an employment fee from a bank account of the vendor to the bank account of the user upon employment of a data by said user (e.g. Col 6 ln 25-40).

17. Regarding claim 10 –

Shear discloses the network-based method as set forth in claim 7, comprising the step of notifying other terminals if a problem is found during the design process for the device (e.g. col 7 ln 20-35).

18. Regarding claim 11 –

Shear discloses the network-based method as set forth in claim 7, comprising the step of the user conducting design for the device, and determining parts to employ through price simulation for meeting a target price (e.g. col 8 ln 25-40).

19. Regarding claim 12 –

Shear discloses the network-based method as set forth in claim 7, comprising the steps of notifying other terminals if a problem is found in a sample; and the designer conducting circuit design for the device, and determining parts to employ through price simulation for meeting a target price (e.g. col 8 ln 25-40).

20. Shear does not expressly a database for use in field of designing circuits.

However, these differences are found only in the non-functional data stored in the database. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F2d 1381, 1385, 217 USPQ 401,404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579,32 USPQ2d 1031 (Fed.Cir.1994).

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21. Claims 13-17 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear (US 5,410,598A).

22. Regarding claims 13 and 25-27 –

Shear discloses a network-based service system, comprising database server for storing a database containing information that are registered by a vendor in advance via a network; and terminal for a user to search said database, determine conditions autonomously, and conduct the project(e.g. Col. 3 ln 60 – col 4 ln 60).

23. Regarding claim 14 –

Shear discloses the network-based service system as set forth in claim 13, wherein said user terminal searches said database on a WWW site, and conducts the project (e.g. Col 4 ln 20-40).

24. Regarding claim 15 –

Shear discloses the network-based service system as set forth in claim 13, comprising means for notifying other terminals if a problem is found during the process (e.g. Col 6 ln 25-40).

25. Regarding claim 16 –

Shear discloses the network-based design service system as set in claim 13, comprising means for the designer to conduct circuit design for the device and determine parts to employ through price simulation for meeting a target price and noise simulation for achieving a required noise proof performance (e.g. col 8 ln 25-40).

26. Regarding claim 17 –

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Shear discloses the network-based service system as in claim 13, comprising means for notifying other terminals if a problem is found during the process and determine parts to employ through price simulation for meeting a target price (e.g. col 8 ln 25-40).

27. Shear does not expressly a database for use in field of designing circuits.

However, these differences are found only in the non-functional data stored in the database. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F2d 1381, 1385, 217 USPQ 401,404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579,32 USPQ2d 1031 (Fed.Cir.1994).

28. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### **Conclusion**

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.



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30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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